

1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte JOSE FEDIDA
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13 Appeal 2007-2366
14 Application 09/526,547
15 Technology Center 3700
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18 Oral Hearing Held: August 8, 2007
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22 Before MURRIEL CRAWFORD, WILLIAM F. PATE, III, and JENNIFER
23 BAHR, Administrative Patent Judges
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27 ON BEHALF OF THE APPELLANT:
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34 The above-entitled matter came to be heard on August 8, 2007,
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37 Public.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

P R O C E E D I N G S

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THE CLERK: Calendar 21, Appeal Number 2007-2366. The attorney is Mr. David Ward.

JUDGE PATE: Good afternoon, Mr. Ward.

MR. WARD: Good afternoon, Your Honors.

JUDGE PATE: We're here for 2007-2366, Jose Fedida; is that correct?

MR. WARD: I believe so, yes.

JUDGE PATE: We've had a chance to look at this case before the hearing, so with that in mind you can start your oral argument now.

MR. WARD: During my presentation today, I'm going to be referring to some notes and some illustrations. I've brought copies of those for your benefit if you'd like to have them.

JUDGE PATE: They are stuff made of record? The examiner has already seen these things?

MR. WARD: No. Well, he's seen the illustrations. Would you like those? In fact, he put them into the record.

JUDGE PATE: Okay. We'll accept the illustrations then. You may approach.

MR. WARD: Thank you.

All the arguments in those handouts have been made of record, but the specific document itself has not.

For this appeal the appellant has filed a brief, a reply brief and a supplemental reply brief, and the examiner has filed an answer and a

1 supplementary answer. I'll primarily be addressing the examiner's
2 supplemental answer, and be referring to that by its initials ESA.

3 Claims 18 through 40 of the application remain pending. Of these,
4 claims 20 and 31 are allowable, and claim 40 is withdrawn.

5 Of importance to this hearing, I'm going to discuss the independent
6 claims 18 and 19, which stand rejected as being anticipated by Goicoechea,
7 and alternatively, as being obvious over Goicoechea.

8 The independent claims define a prosthetic structure such as a stent
9 used to hold a blood vessel open. Goicoechea fails to disclose or suggest
10 two of the features recited in these claims. I'm going to be referring to these
11 features as feature I and feature II.

12 Feature I comprises -- please excuse me while I read this. Feature I
13 comprises "links having a sole central portion and two loops, one loop at
14 each of the ends of the central portion entraps a respective one of two
15 corrugations that are to be linked together."

16 The corrugations are, essentially, filaments of a mesh, much like a
17 fishnet -- those kind of filaments. If you look at appellant's figure 2, you can
18 see what the link looks like. It's an S-shape configuration that holds two
19 different elements and at each end of the link are loops that enclose those
20 elements.

21 Feature II relates to "clearance between the corrugation and the closed
22 loop entrapping the corrugation."

23 In the ESA the anticipation rejection states that feature I is inherent
24 and that feature II is obvious. For the obviousness rejection, ESA proposes
25 that feature I is well known, and feature II is obvious.

26 I'm going to address the anticipation and obviousness rejections

1 separately beginning with the anticipation rejection.

2 MS. CRAWFORD: I thought he said both of those features were
3 inherent for the anticipation rejection.

4 MR. WARD: Feature II?

5 MS. CRAWFORD: Yes.

6 MR. WARD: Can you point to a location?

7 MS. CRAWFORD: No, it's just in my notes.

8 MR. WARD: I'm not aware -- in the answer -- not the supplementary
9 answer -- the examiner did propose that Goicoechea disclosed that feature.
10 However, presumably based on appellant's remarks in response to that
11 answer, that basis of supporting the rejections seems to have been
12 withdrawn.

13 It's not made in the supplementary answer. I will address it if you
14 like, though, at any time that you like.

15 I'm going to refer to the third page of the illustrations. The examiner
16 has made a blowup of Goicoechea's mesh unit there with a staple as shown
17 there.

18 The examiner proposes that the staple corresponds to the claimed
19 links, and states that a staple inherently has a central portion and a loop at
20 each end of the central portion that entraps a separate element to be linked
21 by the staple.

22 Additionally, ESA states that the two loops of a staple inherently
23 cannot entrap the same elements. With respect to the first feature, a stapler
24 inherently has two loops. Appellant disagrees.

25 For instance, a wire staple -- a staple that holds a wire or cable up to a
26 piece of wood, or wall, or some other structure -- is often U-shaped or

1 shaped like a parabola with pointy ends on the ends, and it's nailed into the
2 structure of the wood to hold the cable there.

3 That type of a staple that you can find at Lowes or Home Depot does
4 not have a straight portion with two loops at the ends. Also --

5 JUDGE PATE: It looks like there's no structure here where the ends
6 of the staple would be embedded here in this figure 4F, right? The staple
7 you're referring to, the two free ends are embedded.

8 MR. WARD: Yes.

9 JUDGE PATE: And there's no surface for these free ends to be
10 embedded.

11 MR. WARD: That's correct.

12 Also, an office stapler often has two positions on the anvil, one that
13 creates loops and one that pushes the ends of the staple outward, so that the
14 staple comes out like this, goes down a little bit to entrap the paper and then
15 further extends out. It does not have loops that are generated in that way.

16 If you go to your office and look at your stapler, you may see that it
17 has those two positions. Thus, a staple does not inherently have two loops at
18 the ends of the central straight portion.

19 With respect to the second part, that a staple inherently has loops that
20 enclose separate elements, the ESA contradicts itself by citing three types of
21 staples that don't have that characteristic.

22 First of all, ESA recites a staple that holds pieces of paper together.
23 Every one of these pieces of paper is held together by both loops of this
24 staple.

25 Also, ESA refers to Contra, the first figure I provided you. You can
26 see here in figure 21 there was a staple that's being crushed against an anvil.

1 As you look in figure 22, you can see how this is used to hold two
2 pieces of organ tissue, 300 and 302, together. Both of those pieces of organ
3 tissue are held by that staple.

4 Similarly, Jarrett -- the second figure -- shows a staple holding a
5 single body organ tissue. Both of the loops going through that one body
6 organ tissue. Thus a staple does not inherently entrap separate elements
7 within each of its loops.

8 Also, if we look at Goicoechea's staple here, we see that -- I'm going
9 to read again, this is his language: "A wire that secures an apex 22 of one
10 hoop 20 to a juxtaposed apex 22 of a neighboring hoop 20 and this wire may
11 be a staple 99e."

12 So as you can see in this blown-up diagram, this is an oval piece of
13 wire that's enclosing two filaments within it. They're juxtaposed -- they're
14 held together -- so it necessarily follows that it's not inherent that a staple has
15 two loops that holds separate elements.

16 Just in summary of that inherency issue, Goicoechea doesn't
17 inherently disclose either one. It doesn't disclose a staple inherently has
18 loops on the ends or that those loops necessarily enclose separate elements.

19 The ESA further proposes that a use of a staple, such as being
20 threaded through a blood vessel, would affect its inherency. Appellant
21 disagrees. A device either has inherent characteristics or it does not. The
22 applied use of the device doesn't make the characteristic any more or less
23 inherent.

24 Now, with respect to feature II, ESA proposes that this feature would
25 be obvious. Again, this is a feature of clearance between the corrugation and
26 the loop.

1 The ESA says it would have been obvious to one of ordinary skill in
2 the art to provide some clearance to allow relative movement between the
3 staple loops and the two opposing apices of stent wire to make the stent
4 flexible.

5 Well, this argument is made with respect to the anticipation rejection
6 and the obviousness of the feature, whether such exists or not, cannot
7 support an anticipation rejection.

8 Would you like for me to address what was stated in the examiner's
9 answer with respect to feature II, or should we pass over that?

10 MS. CRAWFORD: You can do it briefly.

11 MR. WARD: In the examiner's answer, the examiner proposed that
12 there was space in between the staple here and these two hoops.

13 Appellant's position is that this is an illustration made for the purposes
14 of helping to understand something, much like an illustration of a car engine
15 helps a mechanic understand a car engine.

16 Many illustrations of car engines are exploded views of that engine.
17 That is not intended to illustrate how the engine will look when it's
18 functioning. It's intended to help you better understand the invention.

19 What Goicoechea says about this figure is the following -- please
20 excuse me for reading: "Juxtaposed apices 22 of neighboring hoops 20 are
21 secured together by securing means 99. In addition to propylene filaments,
22 the securing means may comprise a loop element 99a of a suture material,
23 for example, to tie the juxtaposed apices together, as shown in figure 4b."

24 Then it provides examples of other ways of securing these. One of
25 them is a staple in figure E, but he uses the word "secure" -- tie together.

26 Well, "together" insinuates one group, one mass brought together.

1 "Secure" means to firmly fasten. To make firm or tight. These things are
2 tied together. He's not saying something like, I tied my horse to the hitching
3 post. He's saying, I tied these things together. They're together, not
4 something tied to something else. Moreover, they're secured to one another.

5 Appellant made these arguments in the reply to the examiner's answer.
6 The examiner has apparently dropped this basis for the rejection. Therefore,
7 as far as I can tell, the anticipation rejection is based on the inherency of
8 feature I, the obviousness of feature II.

9 I'm going to move on quickly to the obviousness rejections. With
10 respect to feature I, the ESA proposes that this feature is well known, or
11 would have been to one of ordinary skill in the art at the time of the
12 invention, for the purpose of linking two opposing apices together.

13 ESA uses the term "well known," but the ESA provides no motivation
14 or no expressed teaching of why this well-known feature would be combined
15 with Goicoechea's structure. It just says it's well known; therefore, it would
16 have been obvious to use.

17 Well, that's insufficient for an obviousness rejection. There must be
18 some motivation to modify Goicoechea's structure to include this supposedly
19 well-known feature.

20 Regardless of whether it's well known, it may well be -- there's no
21 motivation provided for integrating it into Goicoechea's structure.

22 JUDGE PATE: I'm clear on your argument. Your argument is not
23 that it's not well known, your argument is there's no motivation to combine?

24 MR. WARD: That's correct. It may well be well known, but there's
25 no motivation provided in the record for modifying Goicoechea's structure to
26 include this well-known feature.

1 JUDGE PATE: You want to talk about number II, or are you not
2 finished with number I?

3 MR. WARD: One more remark.

4 JUDGE PATE: Okay, go ahead.

5 MR. WARD: This does have to do with feature II. The ESA
6 proposes that it would be also obvious to further modify this modification.
7 In other words, we've integrated a component in Goicoechea's structure.
8 Now the ESA proposes it would be obvious to modify this component that
9 was integrated.

10 Well, there's no motivation to integrate that feature; therefore, there
11 can't be any motivation to modify the integrated feature.

12 Is that point clear?

13 JUDGE PATE: That's clear.

14 MR. WARD: I am going to move on to feature II now. Again, I'm
15 going to read. Goicoechea discloses that the sinuous configuration of each
16 turn 20 of the wire skeleton of stent 10 allows the prosthesis to be
17 compressed resiliently radially inwards so that it can be received in a
18 catheter for delivery to an intra luminal site of the aortic artery.

19 Well, Goicoechea relies on the sinuous wire skeleton of his stent to
20 achieve the compressibility, or flexibility as the ESA refers to it, but it's
21 compressibility. It's using the sinuous nature of these filaments to compress
22 down so that it can be put into the artery.

23 Goicoechea is not disclosing or suggesting that any further methods
24 need to be used to achieve flexibility, like what appellant has disclosed that
25 you have links that have some space so they can flex this way.

26 The only motivation that the ESA has provided for modifying

1 Goicoechea's structure is what appellant has disclosed in his application --
2 what he's doing to achieve flexibility.

3 Goicoechea has his own method of achieving compressibility,
4 flexibility, and apparently he was well satisfied with that. He didn't disclose
5 any other manner or structure of achieving that. Therefore, there's no
6 motivation in the record for modifying his structure. Further, he's achieved
7 what he wanted to.

8 Am I making that clear?

9 JUDGE PATE: I understand the argument.

10 MR. WARD: Do you have a disagreement with the argument? In
11 other words, where in the record, other than applicant's disclosure, is there
12 some motivation to further modify Goicoechea's structure to achieve this
13 compressibility?

14 Goicoechea achieves that compressibility in its own way, seemingly
15 happy with the success of that. He doesn't disclose any other ways, or
16 suggest any other ways of achieving that. There's just no suggestion in the
17 record to modify his structure in any way.

18 JUDGE PATE: The same argument would hold for every
19 obviousness rejection that's ever been made. The basic reference was happy
20 with their structure.

21 You know, that's what you're saying -- Goicoechea was happy with
22 his structure, and therefore, there's no reason to modify it.

23 So there's no such thing as obviousness under that view.

24 MR. WARD: Let me point this out. If you have another reference, or
25 some other teaching somewhere, whether it's well known to us or in another
26 reference, that says if you modify this, you can achieve something further.

1 Well, the only place the examiner is getting that is from applicant's
2 disclosure. The ESA has not referred to anything else that would provide
3 the teaching to modify Goicoechea.

4 As far as a single document, in the absence of any other teaching, I
5 agree with how you stated that. He's perfectly satisfied with that. If there's
6 no other teaching in the art, there's no teaching to modify what's in that
7 reference. There's no teaching other than what's in that reference.

8 But here the examiner doesn't propose that there's some knowledge to
9 those of ordinary skill in the art that would suggest modifying this to achieve
10 something. At the most, he's just going to applicant's disclosure and saying,
11 Well, here it is. Here's the reason to do it.

12 That would be fine if he could find some support elsewhere besides
13 applicant's disclosure, but it just appears that he's relying on the hindsight
14 afforded by applicant's disclosure. Does that help clarify?

15 JUDGE PATE: I understood your position the first time.

16 MR. WARD: But you disagree with that --

17 JUDGE PATE: I don't have to tell you right now. That's the best
18 thing about this job.

19 MR. WARD: In summary, with respect to feature I, the ESA provides
20 no suggestion or motivation to modify Goicoechea's structure.

21 With respect to feature II, again, there's just no suggestion to modify
22 Goicoechea's structure to include this additional feature of the claims. Both
23 the independent claims recite these features.

24 That's the end of my presentation. If you have any questions, I'd be
25 happy to answer them.

26 JUDGE PATE: Any questions?

1 We have no questions. Thank you very much, Mr. Ward, for your
2 arguments, and we'll take this case under advisement.

3 MR. WARD: Thank you very much for your time today. I greatly
4 appreciate it.

5 (Whereupon, the proceedings at 2:20 p.m. were concluded.)